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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/659,693
Filing Date: September 11, 2000
Appellant(s): SUTARDJA, SEHAT

Michael D. Wiggins
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 September 2010 appealing from the Office action mailed 01 March 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 173 – 190 stand rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,192,340	Abecassis	2-2001
6,332,175	Birrell	12-2001
6,233,393	Yanagihara	5-2001
5,903,871	Terui	5-1999
7,444,439	Du	10-2008
6,502,194	Berman	12-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 173 – 175, 178, 182 – 184 and 187 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell (U.S. Patent 6,332,175) in view of Yanagihara (U.S. Patent 6,233,393).

Regarding **Claim 173**, Birrell discloses:

A media device comprising:

a memory (108 or 112);

a storage device to store compressed media data, the compressed media data having a compression format (hard disk 104); and

a process configured to decompress compressed media data (decompression procedure 168).

Birrell does not explicitly disclose storing the process on the storage device as claimed. However, Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time of the invention to store the procedures in the storage device instead of in the ROM. Both the ROM and the disk are non-volatile memory devices and therefore are suitable to store system procedure programs. It would be an obvious variation to store the programs in the disk instead of the ROM. One would have been motivated to do so in order to manufacture the Birrell player with

less parts and thus making it less costly as the ROM would not be required if the programs were stored instead on the disk.

Birrell further discloses:

a programmable processor (CPU 102) configured to be programmed

as a storage controller to retrieve the compressed media data from the storage device (i.e. the system contains multiple control programs executed by the data processor, on being a play procedure; Fig. 1 element 102 and col. 5 lines 5 – 33; the play control logic, which is part of the play procedure as shown in Fig. 2, transfers data from the disk to RAM; col. 6 lines 14 – 16); and

as a digital signal processor to decompress the compressed media data (i.e. the system contains multiple control programs executed by the data processor, one being a decompression procedure; col. 5).

Birrell does not explicitly disclose:

a plurality of processes to decompress the media data.

However, at the time the invention was made, Examiner takes official notice that a number of compression standards were available similar to the MP3 standard. It would have been obvious to one of ordinary skill in the art to add decompression procedures for each of these standards in the Birrell device. It would be desirable to have a single device for decompression a number of compression procedures known in the art rather than having to purchase a number of devices to perform the same task.

Further, Birrell does not explicitly disclose:

wherein the programmable processor is further configured to

determine the compression format of the compressed media data;

select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data; and

decompress the compressed media data based on the first process; and

an output device to output the decompressed media data from the media device.

Yanagihara discloses a device with a general controller that determines the compression of audio data and sets the decoder to decompress the given compression; Fig. 15.

Applying this to Birrell's device discloses:

wherein the programmable processor (Birrell's 102) is further configured to

determine the compression format of the compressed media data (Birrell's processor 102 configured like the general purpose processor of Yanagihara to determine the compression);

select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data (retrieving the decompression procedure stored in Birrell to set the decoder as taught by Yanagihara); and

decompress the compressed media data based on the first process (i.e. decompress via CPU 102); and

an output device to output the decompressed media data from the media device (130).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the compression determination technique taught by Yanagihara to the device taught by Birrell. Doing so would be nothing more than applying a known technique (i.e. decompressing audio data of multiple types via a single processor) to a known device (i.e. Birrell's CPU) ready for improvement to yield predictable results (i.e. Birrell's device can be adapted to decompress multiple compression types).

As further evidence these features are obvious and would lead to predictable results, see Du (U.S. 7,444,439) which teaches a portable player with a decoder 58, that receives audio data and decodes the data according to a stored decoder algorithm. Additionally, the algorithm can be stored in flash memory and loaded as needed. Further, the decoder can be updated or modified; see col. 5 lines 20 - 47.

Regarding **Claim 174**, in addition to the elements stated above regarding claim 173, the combination further discloses:

wherein the digital signal processor includes a decoder to decompress the compressed media data (i.e. the processor includes a decompression procedure for decompressing compressed audio files; col. 5 lines 20 – 25).

Regarding **Claim 175**, in addition to the elements stated above regarding claim 173, the combination further discloses:

the compressed media data includes a plurality of media selections (i.e. media files on disk 104);

the programmable processor transfers first portions of at least one of the plurality of media selections from the storage device to the memory (i.e. the system contains multiple control programs executed by the data processor, on being a play procedure; Fig. 1 element 102 and col. 5 lines 5 – 33; the play control logic, which is part of the play procedure as shown in Fig. 2, transfers data from the disk to RAM; col. 6 lines 14 – 16; the play control logic maintains sufficient portions of data in the RAM to ensure that there is no break in the playback; col. 6 lines 5 – 28);

the output device outputs the first portions from the media device (i.e. as the audio data is played back, the portions present in RAM are read out to the audio out jack; col. 6 lines 5 – 28);

a user selects a particular one of the plurality of media selections in response to the first portions (i.e. navigation of the playlist, fwd, rev, etc; see below); the programmable processor retrieves a remaining portion of the particular one of the plurality of media selections in response to the user selection (i.e. next would retrieve the next song, continuing playback w/ no input would continue retrieving the current song; see below); and the output device outputs the remaining portion of the particular one of the plurality of media selections (i.e. user selections are added to a play list, which is a queue of tracks to be played by the system; col. 5 lines 1 – 3 and as the audio data is played back, the portions present in RAM are read out to the audio out jack; col. 6 lines 5 – 28).

Regarding **Claim 178**, in addition to the elements stated above regarding claim 173, the combination further discloses:

wherein the processor includes a single integrated circuit, the single integrated circuit comprising:

the programmable processor (i.e. CPU 102 is a general purpose processor); and

a read channel hat is responsive to the storage controller to read data from the storage device (i.e. any of the inputs to CPU 102 that reads commands or inputs data for playback/retrieval).

Claims 182 – 184 and 187 are rejected under the same grounds stated above.

Claims 179 – 181 and 188 – 190 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell (U.S. Patent 6,332,175) in view of Yanagihara (U.S. Patent 6,233,393)in further view of Terui (U.S. Patent 5,903,871).

Regarding **Claim 179**, in addition to the elements stated above regarding claim 173, the combination fails to explicitly disclose:

an input circuit to receive media data, wherein the digital signal processor compresses the received media data.

Terui discloses:

an input circuit to receive media data, (i.e. a microphone for converting voice to an electric signal and an analog to digital converter for converting it to a digital signal; col. 3 lines 4 – 12);

wherein the digital signal processor compresses the received media data. (i.e. the digital signal is compressively transformed; col. 3 lines 25 – 29).

It would have been obvious to one of ordinary skill in the art to add the features of Terui to the elements of the combination in order to integrate a portable voice recorder into Birrell's portable player. One would have been motivated to do so in order to enhance the operation of the player to provide a voice recording and reproducing apparatus which can easily store and manage a voice file (Terui col. 1 lines 48 - 50) thus eliminating the need for multiple devices to perform similar tasks.

Regarding **Claim 180**, in addition to the elements stated above regarding claim 179, the combination further discloses:

wherein the digital signal processor includes an encoder to compress the received media data (i.e. the digital signal is compressively transformed; col. 3 lines 25 – 29).

Regarding **Claim 181**, in addition to the elements stated above regarding claim 179, the combination further discloses:

wherein the storage device stores a plurality of compression processes (see above rejections) and the digital signal processor compresses the received media data based on a selected one of the plurality of compression processes (compressively transforming the input audio based on one of the compression procedures).

Claims 188 - 190 are rejected under the same grounds stated above.

Claims 173, 174, 182 and 183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Du (U.S. Patent 7,444,439) in view of Yanagihara (U.S. Patent 6,233,393).

Regarding **Claim 173**, Du discloses:

A media device comprising:

a memory (52);

a storage device to store compressed media data, the compressed media data having a compression format (HDD 20); and

a process configured to decompress compressed media data (i.e. decoder algorithm; Col. 5).

Du does not explicitly discloses storing the process on the storage device as claimed. However, Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time of the invention to store the decoder algorithms in the storage device instead of in the Flash memory. Both the Flash memory and the disk are non-volatile memory devices and therefore are suitable to store system decoder algorithms. It would be an obvious variation to store the algorithms on the disk instead of the flash memory. One would have been motivated to do so in order to manufacture the Du player with less parts and thus making it less costly as the ROM would not be required if the programs were stored instead on the disk.

Du further discloses:

a programmable processor configured to be programmed as a storage controller to retrieve the compressed media data from the storage device (MP3 controller includes processor 48 which loads MP3 files from the disk into memory 50; Fig. 4); and

as a digital signal processor to decompress the compressed media data (decoder circuitry 56).

Du fails to explicitly disclose:

a plurality of processes to decompress the media data.

However, at the time the invention was made, Examiner takes official notice that a number of compression standards were available similar to the MP3 standard. It would have been obvious to one of ordinary skill in the art to add decompression procedures for each of these standards in the Birrell device. It would be desirable to

have a single device for decompression a number of compression procedures known in the art rather than having to purchase a number of devices to perform the same task.

Further, Du explicitly notes that the controller is not limited to only MP3 decompression and can be modified to decompress any compressed audio type; last para in col. 6 to top of col. 7. Given that Du discloses retrieving a decoder algorithm from memory, and that the controller can be modified to decompress any type of compression, modifying the device to store numerous algorithms for multiple compression types would have been nothing more than applying a known technique to a known device yielding predictable results.

Further, Du fails to explicitly disclose:

wherein the programmable processor is further configured to determine the compression format of the compressed media data;

select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data; and

decompress the compressed media data based on the first process; and

an output device to output the decompressed media data from the media device.

Yanagihara discloses a device with a general controller that determines the compression of audio data and sets the decoder to decompress the given compression; Fig. 15.

Applying this to Du's device discloses:

wherein the programmable processor is further configured to

determine the compression format of the compressed media data (i.e. determining the compression as taught by Yanagihara in order to load the proper decoder algorithm in Du);

select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data (retrieving the decoder algorithm stored in Du to set the decoder as taught by Yanagihara); and

decompress the compressed media data based on the first process (i.e. decompress via 56); and

an output device to output the decompressed media data from the media device (any of the outputs in Fig. 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the compression determination technique taught by Yanagihara to the device taught by Du. Given that Du can be adapted to be able to decode multiple compression types, it would be necessary to determine which compression is present in order to decode properly. Thus, doing so would be nothing more than applying a known technique (i.e. decompressing audio data of multiple types via a single processor) to a known device ready for improvement to yield predictable results.

Regarding **Claim 174**, in addition to the elements stated above regarding claim 173, the combination further discloses:

wherein the digital signal processor includes a decoder to decompress the compressed media data (decoder 58 also 56).

Claims 182 and 183 are rejected under the same grounds stated above.

Claims 175 – 177 and 184 – 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Du (U.S. Patent 7,444,439) in view of Yanagihara (U.S. Patent 6,233,393) and in further view of Berman (U.S. Patent 6,502,194).

Regarding **Claim 175**, in addition to the elements stated above regarding claim 173, the combination further discloses:

the compressed media data includes a plurality of media selections (i.e. audio files on HDD 20).

The combination fails to explicitly disclose:

the programmable processor transfers first portions of at least one of the plurality of media selections from the storage device to the memory;

the output device outputs the first portions from the media device;

a user selects a particular one of the plurality of media selections in response to the first portions;

the programmable processor retrieves a remaining portion of the particular one of the plurality of media selections in response to the user; and

the output device outputs the remaining portion of the particular one of the plurality of media.

Berman discloses a preview device that plays compressed audio files on a computing device (akin to the Laptop of Du); Figs, 1, 11 and 12.

Applying Berman previewing technique to the laptop computer of Du discloses:

the programmable processor transfers first portions of at least one of the plurality of media selections from the storage device to the memory (loading from HDD 20 in Du into the buffer, now modified by Berman to load multiple preview clips into a buffer; see Figs. 11 and 12);

the output device outputs the first portions from the media device (i.e. playback via outputs in Fig. 4 of Du);

a user selects a particular one of the plurality of media selections in response to the first portions (user can select playback as taught by Du, of one of the segments loaded into the staging memory as taught by Berman);

the programmable processor retrieves a remaining portion of the particular one of the plurality of media selections in response to the user (playback when a new track is selected, Fig. 5 of Berman; buffer selected has priority over all buffers, data flow into this buffer is maintained such that continuous playback is guaranteed); and

the output device outputs the remaining portion of the particular one of the plurality of media (i.e. playback via outputs in Fig. 4 of Du).

It would have been obvious to one of ordinary skill in the art to apply the buffering/previewing of Berman to the buffer of Du. Doing so would have been nothing more than applying a known technique (i.e. buffering of multiple songs) to a known device (i.e. media player of Du) ready for improvement tot yield predictable results.

Regarding **Claim 176**, in addition to the elements stated above regarding claim 175, the combination further discloses:

the programmable processor retrieves the remaining portion if the user selects (skip/play or another user input) the particular one of the plurality of media selections within a predetermined period (10 seconds pre-buffered) after the output device outputs one of the first portions corresponding to the particular one (i.e. playback is initiated/another song is skipped to before the 10 seconds of audio data in the buffer is consumed; the buffer selected has priority over all buffers, data flow into this buffer is maintained such that continuous playback is guaranteed; see Memory Buffering control section in Col. 11 and 12).

Regarding **Claim 177**, in addition to the elements stated above regarding claim 173, the combination further discloses:

Wherein the output device continues the outputting of the first portions if the user does not select the particular one within the predetermined period (data flow into the current buffer is maintained such that continuous playback is guaranteed if no command is given; see Memory Buffering control section in Col. 11 and 12).

Claims 184 - 186 are rejected under the same grounds stated above.

(10) Response to Argument

In section A. 1. (a) Appellant alleges:

> Birrell fails to disclose that the programmable processor is configured to determine the compression format of the compressed media data, select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data, and decompress the compressed media data based on the first process as recited in Claim 173.

Appellant alleges regarding the above:

> Further, the Examiner acknowledges that Birrell does not disclose a plurality of processes, and instead takes official notice that "a number of compression standards were available." (See Page 6 of the Office Action). Appellant respectfully disagrees that a media device including a storage device to store a plurality of processes would be obvious merely because "a number of compression standards were available." More specifically, Appellant respectfully submits that a number of compression standards merely being "available" is not analogous to including a storage device to store the plurality of processes and to retrieving a selected one of the processes as claim 173 recites.

Examiner disagrees. Examiner maintains that there were numerous known compression standards at the time the present application was submitted. For example, MPEG, AAC, DTS, windows media, real audio comprise just a few of the possible compression techniques. It would not make sense to one in the art to create a device that would only be able to reproduce one of these standards.

As stated previously, it is likely that Birrell anticipates a number of compresses techniques to be decompressed. Throughout the specification, Birrell refers the MP3 standard in example form and discusses compression and decompression in generic terms. Birrell is directed to retrieving a decompression procedure to perform the decompression. While Birrell is not generally concerned with compression format, the device is specifically suited to be adapted to decode multiple compression techniques. The only thing the device would need would be additional standards to retrieve. Yanagihara provides this teaching, namely the retrieval of multiple compression standards for decompression.

Appellant further alleges:

> For example, the Examiner merely states that "it would be desirable to have a single device...rather than purchase a number of devices."
>
> This brief explanation falls far short of the type of explicit analysis that is required by the Supreme Court in KSR Int'l v. Tele/lex Inc., 127 $.Ot. 1727 (2007). Absent such an express teaching or suggestion in the references, the explicit analysis and reasoning must be supplied by the Examiner. id. In other words, the Examiner is required to provide explicit reasoning as to why one skilled in the art would be motivated to construct a media device including a storage device to store a plurality of processes, each of the plurality of processes configured to decompress compressed media data.
>
> Here, the Examiner merely notes that "it would be desirable to have a single device for decompression." The Examiner fails to provide explicit analysis and reasoning for why one skilled in the art would arrive at the specific solution (i.e. storing a plurality of processes and selecting one of the processes according to specific criteria) provided by Appellant's invention as required.

Examiner disagrees. The explicit reasoning is provided within the rejection. This reasoning being “It would be desirable to have a single device for decompression a

number of compression procedures known in the art rather than having to purchase a number of devices to perform the same task."

Birrell at a minimum discloses decompression of a single compression format. AS stated above, it would be a trivial modification to provide multiple types of compression, i.e. "While Birrell is not generally concerned with compression format, the device is specifically suited to be adapted to decode multiple compression techniques. The only thing the device would need would be additional standards to retrieve. Yanagihara provides this teaching, namely the retrieval of multiple compression standards for decompression."

Thus, rather than a manufacturer having to construct a single device such as Birrell's for each of MP3, AAC and WMA etc, they would need only to include the compression standards for retrieval in Birrell and one device could decode all of the types of compression.

Appellant further alleges:

> Further, while Appellant recognizes that the Examiner is entitled to support a rejection based on common knowledge in the art, Appellant respectfully submits that the Examiner can only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration of being "well-known" in the art. See, MPEP § 2144.03, In re Knapp Monach Co., 132 USPQ 340, 341 (CCPA 1973). Here, Appellant respectfully submits that Birrell falls short of the aforementioned "unquestionable demonstration" that is required.
>
> Because Birrell does not disclose the limitation of a storage device to store a plurality of processes as claim 173 recites, Appellant respectfully submits that Birrell falls short of the "unquestionable demonstration" that is required to support official notice.

Examiner agrees. Of course Birrell fall short of the “unquestionable demonstration” that is required to support official notice. Birrell’s device does not explicitly teach the multiple format retrieval as acquiesced by the Examiner. That portion of the rejection is based upon obviousness of what is known in the art and what can be applied to Birrell. Examiner has never relied upon Birrell to disclose these teachings. The Examiner has relied upon well known knowledge (i.e. number of compression standards available), Birrell’s retrival of a compression procedure, Yanagiharas determination of multiple compression types, and a trivial modification of Birrell to provide multiple types of compression.

Regarding the unquestionable demonstration of the official notice, Abecassis was provided in the prior rejection to show that “a multimedia player can accommodate a plurality of compression and decompression techniques to both retrieve and decompress,” col; 13 lines 1 – 10.

Appellant further alleges:

> Further, the Examiner cites Column 13, Lines 10-15 of Abecassis (U.S. Pat. No. 6,192,340) to disclose that "portable players are known to decompress a plurality of compression technologies." (See Page 2 of the Office Action). Here again, Abecassis only discloses that the multimedia player can decompress a plurality of compression technologies, not that the player itself i) includes a storage device to store the plurality of processes, ii) determines the compression format of the compressed media data, and iii) selects a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data.

Examiner disagrees. Abecassis isn't required to disclose i), ii) and iii) above as Abecassis was only provided to show that "portable players are known to decompress a plurality of compression technologies." i), ii) and iii) are met in the well known knowledge (i.e. number of compression standards available), Birrell's retrieval of a compression procedure, Yanagiharas determination of multiple compression types, and a trivial modification of Birrell to provide multiple types of compression. Abecassis is merely brought in to satisfy the official notice request.

Appellant further alleges:

> Instead, Abecassis merely discloses that the audio itself, received at a media player from an external device such as a digital camera, already includes the required decompression software. For example, "the audio itself could include within and provide the required decompression software." (See Column 13, Lines 20-22 of Abecassis). Accordingly, because the audio itself includes the decompression software, there is no need for the processor to determine the compression format of the compressed media data and select one of the plurality of processes stored in the storage device based on the compression format. In other words, like Birrell, Abecassis appears to disclose that the media player receives the decompression processes from an external device along with the received media data and does not select one of the plurality of processes, stored on the storage device, based on a determined compression format.

Again, the above is irrelevant to the rejection at hand. Abecassis is only provided to show "portable players are known to decompress a plurality of compression technologies." The rejection itself is a combination of well known knowledge (i.e. number of compression standards available), Birrell's retrieval of a compression procedure, Yanagiharas determination of multiple compression types, and a trivial

modification of Birrell to provide multiple types of compression. Abecassis is merely brought in to satisfy the official notice request.

In section A. 1. (b) Applicant alleges:

Yanagihara fails to disclose that the programmable processor is configured to determine the compression format of the compressed media data, select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data, and decompress the compressed media data based on the first process as recited in Claim 173

Appellant alleges regarding the above:

> The Examiner alleges that Yanagihara discloses "a device with a general controller that determines the compression of audio data and set the decoder to decompress the given compression," citing FIG. 15 of Yanagihara. (See Page 6 of the Office Action). Appellant respectfully submits that FIG. 15 and the corresponding description are not analogous to the limitations that claim 173 recites.
>
> For example, Appellant respectfully notes that Yanagihara states that "[t]he general controller section 21 may set a decoder, or a parameter(s) pertaining thereto, in the presentation engine 12 in accordance with the received control data." (Col. 2, lines 10-13). The general control data is received from a DVD 101. (Col. 2, lines 5-6). Yanagihara discloses that the control data is received along with the encoded media data from the same source (i.e. the DVD 101). The general controller section 21 sets decoder parameters based on the general control data. Consequently, Yanagihara discloses, at best, receiving encoded media data and general control data, and decoding the encoded media data in accordance with the general control data. Yanagihara is completely absent of any teaching or suggestion that the programmable processor is configured to select a first process of the plurality of processes stored in the storage device based on the

> compression format of the compressed media data, and decompress the compressed media data based on the first process.

Examiner generally agrees with the above analysis of Yanagihara. Where the argument falls short however, is the lack of consideration to the combination of Birrell in view of Yanagihara. Applicant is essentially pinpointing features of Yanagihara in a vacuum, without consideration as to how it applies to Birrell in the combination made in the rejection. Yanagihara has never been used to teach the retrieval of the compression portion. Birrell clearly teaches retrieving the compression procedure as shown in the final rejection.

As it has been stated numerous times, Birrell fails to disclose the determination and selection limitations claimed. Yanagihara clearly teaches determination "for example, the general controller section 21 may determine the compression of the speech data (such as one of MPEG-Audio, Dolby AC-3, and Liner PCM) to be regenerated or reproduced from the general control data," and selection "Such general control data may include general information pertaining to a stream of data (such as, the type of broadcast system (NTSC, PAL), the type of compression mode, and so forth) and parental information. The general controller section 21 may set a decoder, or a parameter(s) pertaining thereto, in the presentation engine 12 in accordance with the received general control data;" Yanagihara col. 2 lines 5 – 26. When applied to Birrell, instead of setting the controller in Yanagihara, Birrell now retrieves a different compression standard.

Appellant further alleges:

> Accordingly, Yanagihara discloses receiving control data along with the compressed media data, not determining the compression format of the compressed media data. Further, Yanagihara discloses setting decoder parameters based on the received control data, not selecting a particular process of a plurality of processes and retrieving the process from a storage device.

Examiner disagrees. Setting the decoder based upon a determined compression procedure is a form of selection. The device will need to select the proper compression setting to set the device properly; see again Yanagihara col. 2 lines 5 - 26.

Appellant further alleges:

> The Examiner further alleges that Yanagihara's reading of decoder parameters is "determination." (See Page 3 of the Office Action). Appellant respectfully submits that even if reading decoder parameters is "determination," which Applicant does not concede, Yanagihara still fails to disclose selecting a particular process of a plurality of processes and retrieving the process from the storage device. Instead, Yanagihara merely discloses setting decoder parameters, not retrieving the process from the storage device.

Yanagihara clearly teaches determination: “the general controller section 21 may **determine** the compression of the speech data (such as one of MPEG-Audio, Dolby AC-3, and Liner PCM). Further as stated above, setting the decoder based upon a determined compression procedure is a form of selection. The device will need to

select the proper compression setting to set the device properly; see again Yanagihara col. 2 lines 5 - 26.

In section A. 1. (c) Appellant alleges:

The Examiner has failed to establish a prima facie case of obviousness

Examiner disagrees. The Examiner has shown what the Birrell reference teaches, and then what hte Birrell reference lacks. Next the Examiner has shown how the Yanagihara reference in combination with the Birrell reference meet these limitations. Finally the Examiner has given a reason for combination. As such, the Graham v. Deer requirements have been met and the burden of showing non-obviousness has shifted to the Appellant.

In section B. 1 (a):

Appellant has provided no additional arguments and thus the rejections of the claims referenced in this section should be upheld for the reasons stated above.

In section . C 1. (a) Appellant alleges:

> Du fails to disclose that the programmable processor is configured to determine the compression format of the compressed media data,

> select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data, and decompress the compressed media data based on the first process as recited in Claim 173.

These argument follow the same reasoning stated above in section A. 1. (a) and should be upheld for the same reasons.

Additionally, it should be noted that Du takes a step further than Birrell and acknowledges the device is capable of decoding multiple forms of compression and should not only be limited to only playing MP3 data; col. 7 lines 1 – 10. Further, Du also discloses loading a decoder algorithm into memory by activation of the controller; col. 5 lines 20 – 35.

Du is only lacking the determination portion, which Yanagihara clearly teaches: or example, “the general controller section 21 may determine the compression of the speech data (such as one of MPEG-Audio, Dolby AC-3, and Liner PCM) to be regenerated or reproduced from the general control data” col. 2 lines 5 – 26.

Appellant further alleges:

> Further, while Appellant recognizes that the Examiner is entitled to support a rejection based on common knowledge in the art, Appellant respectfully submits that the Examiner can only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration of being "well-known" in the art. See, MPEP § 2144.03, In re Knapp Monach Co., 132 USPQ 340, 341 (CCPA 1973). Here, Appellant respectfully submits that Du falls short of the aforementioned "unquestionable demonstration" that is required.
>
> Because Du does not disclose the limitation of a storage device to store a plurality of processes as claim 173 recites, Appellant respectfully submits that Du falls short of the "unquestionable demonstration" that is required to support official notice.

Examiner disagrees. Du clearly teaches multiple formats col. 7 lines 1 – 10, and thus meets " a number of compress standards were available" Du does not need to disclose "a storage device to store a plurality of process" in order to satisfy the contention that "a number of compression standards were available" cannot be unquestionably demonstrated. Du discloses retrieval of an algorithm from storage and since Du discloses decoding multiple formats, it logically follows that these formats can also be retrieved.

Addtionally, regarding the unquestionable demonstration of the official notice, Abecassis was provided in the prior rejection to show that "a multimedia player can accommodate a plurality of compression and decompression techniques to both retrieve and decompress," col; 13 lines 1 – 10, as well as the Du reference itself which teaches multiple compression formats.

Appellant further alleges:

> Further, the Examiner cites Column 13, Lines 10-15 of Abecassis (U.S. Pat. No. 6,192,340) to disclose that "portable players are known to decompress a plurality of compression technologies." (See Page 2 of the Office Action). Here again, Abecassis only discloses that the multimedia player can decompress a plurality of compression technologies, not that the player itself i) includes a storage device to store the plurality of processes, ii) determines the compression format of the compressed media data, and iii) selects a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data.
>
> Instead, Abecassis merely discloses that the audio itself, received at a media player from an external device such as a digital camera, already includes the required decompression software. For example, "the audio itself could include within and provide the required decompression

> software." (See Column 13, Lines 20-22 of Abecassis). Accordingly, because the audio itself includes the decompression software, there is no need for the processor to determine the compression format of the compressed media data and select one of the plurality of processes stored in the storage device based on the compression format. In other words, Abecassis appears to disclose that the media player receives the decompression processes from an external device along with the received media data and does not select one of the plurality of processes, stored on the storage device, based on a determined compression format.

Again, the above is irrelevant to the rejection at hand. Abecassis is only provided to show "portable players are known to decompress a plurality of compression technologies." This argument holds even less weight in the Du and Yanagihara than in the Birrell and Yanagihara rejection as Du clearly teaches multiple compressions.

In section C. 1. (b) Applicant alleges:

Yanagihara fails to disclose that the programmable processor is configured to determine the compression format of the compressed media data, select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data, and decompress the compressed media data based on the first process as recited in Claim 173

Appellant alleges regarding the above:

> The Examiner alleges that Yanagihara discloses "a device with a general controller that determines the compression of audio data and set the decoder to decompress the given compression," citing FIG. 15 of Yanagihara. (See Page 6 of the Office Action). Appellant respectfully submits that FIG. 15 and the corresponding description are not analogous to the limitations that claim 173 recites.

> For example, Appellant respectfully notes that Yanagihara states that "[t]he general controller section 21 may set a decoder, or a parameter(s) pertaining thereto, in the presentation engine 12 in accordance with the received control data." (Col. 2, lines 10-13). The general control data is received from a DVD 101. (Col. 2, lines 5-6). Yanagihara discloses that the control data is received along with the encoded media data from the same source (i.e. the DVD 101). The general controller section 21 sets decoder parameters based on the general control data. Consequently, Yanagihara discloses, at best, receiving encoded media data and general control data, and decoding the encoded media data in accordance with the general control data. Yanagihara is completely absent of any teaching or suggestion that the programmable processor is configured to select a first process of the plurality of processes stored in the storage device based on the compression format of the compressed media data, and decompress the compressed media data based on the first process.

Examiner generally agrees with the above analysis of Yanagihara. Where the argument falls short however, is the lack of consideration to the combination of Du in view of Yanagihara. Applicant is essentially pinpointing features of Yanagihara in a vacuum, without consideration as to how it applies to Du in the combination made in the rejection. Yanagihara has never been used to teach the retrieval of the compression portion. Du clearly teaches retrieving the compression procedure as shown in the final rejection and above.

As it has been stated numerous times, Du fails to disclose the determination and selection limitations claimed. Yanagihara clearly teaches determination “for example, the general controller section 21 may determine the compression of the speech data (such as one of MPEG-Audio, Dolby AC-3, and Liner PCM) to be regenerated or reproduced from the general control data,” and selection “Such general control data may include general information pertaining to a stream of data (such as, the type of

broadcast system (NTSC, PAL), the type of compression mode, and so forth) and parental information. The general controller section 21 may set a decoder, or a parameter(s) pertaining thereto, in the presentation engine 12 in accordance with the received general control data;" Yanagihara col. 2 lines 5 – 26. When applied to Du, instead of setting the controller in Yanagihara, Du now retrieves a different compression standard.

Appellant further alleges:

> Accordingly, Yanagihara discloses receiving control data along with the compressed media data, not determining the compression format of the compressed media data. Further, Yanagihara discloses setting decoder parameters based on the received control data, not selecting a particular process of a plurality of processes and retrieving the process from a storage device.

Examiner disagrees. Setting the decoder based upon a determined compression procedure is a form of selection. The device will need to select the proper compression setting to set the device properly; see again Yanagihara col. 2 lines 5 - 26.

Appellant further alleges:

> The Examiner further alleges that Yanagihara's reading of decoder parameters is "determination." (See Page 3 of the Office Action). Appellant respectfully submits that even if reading decoder parameters is "determination," which Applicant does not concede, Yanagihara still fails to disclose selecting a particular process of a plurality of processes and retrieving the process from the storage device. Instead, Yanagihara

> merely discloses setting decoder parameters, not retrieving the process from the storage device.

Yanagihara clearly teaches determination: "the general controller section 21 may **determine** the compression of the speech data (such as one of MPEG-Audio, Dolby AC-3, and Liner PCM). Further as stated above, setting the decoder based upon a determined compression procedure is a form of selection. The device will need to select the proper compression setting to set the device properly; see again Yanagihara col. 2 lines 5 - 26.

In section C. 1. (c) Appellant alleges:

The Examiner has failed to establish a prima facie case of obviousness

Examiner disagrees. The Examiner has shown what the Du reference teaches, and then what the Du reference lacks. Next the Examiner has shown how the Yanagihara reference in combination with the Du reference meet these limitations. Finally the Examiner has given a reason for combination. As such, the Graham v. Deer requirements have been met and the burden of showing non-obviousness has shifted to the Appellant.

In section D. 1. Appellant alleges:

> Further, claim 175 recites that the programmable processor transfers first portions of at least one of the plurality of media selections from the storage device to the memory, the output device outputs the first portions from the media device, a user selects a particular one of the

> plurality of media selections in response to the first portions, and the programmable processor retrieves a remaining portion of the particular one of the plurality of media selections in response to the user selection.
>
> In other words, (i) the programmable processor transfers the first portions, (ii) the output device outputs the first portions, (iii) the user selects one of the media selections in response to the first portions, and (iv) the programmable processor retrieves the remaining portion in response to the user selection.
>
> The Examiner acknowledges that Du fails to disclose these limitations and instead relies on Berman to make up for the deficiencies of Du. Appellant respectfully submits the Berman fails to disclose that the user selects one of the media selections in response to the first portions, and the programmable processor retrieves the remaining portion in response to the user selection.
>
> Instead, Berman discloses portions of songs are initially downloaded in response to user selection. (See Column 11, Line 65 through Column 12, Line 5). Specifically, the user selects songs 1, 2, and 3, and then "once a sizeable amount of compressed audio information is stored for that song, the playback unit begins to process the information and play the song." (See Column 12, Lines 1-4). In other words, the user selects a song before the first portions are transferred. In contrast, claim 175 recites that the user selects one of the media selections in response to the first portions. Then, after the selection, the programmable processor retrieves the remaining portion in response to the user selection. As such, Appellant respectfully submits that the structure of Berman is in direct contradiction to these limitations.

Examiner disagrees. The teaching of user selecting a song before the first portions are transferred does not preclude the art from reading on the claimed limitations as this feature is not explicitly excluded. The set of events that occurs after that initial selection in Berman is exactly what Appellant is attempting to claim, the device transfers portions of clips into buffers, previews these, then waits for a selection, when the selection is made, the remaining portion of the preview is downloaded for playback… this is exactly the same as claimed:

the programmable processor transfers first portions of at least one of the plurality of media selections from the storage device to the memory (i.e. portions of the previews);

the output device outputs the first portions from the media device (preview playback);

a user selects a particular one of the plurality of media selections in response to the first portions (selection of one of the previews);

the programmable processor retrieves a remaining portion of the particular one of the plurality of media selections in response to the user (downloading the remaining portion of the preview for playback); and

the output device outputs the remaining portion of the particular one of the plurality of media (i.e. playback).

It does not logically follow that because Berman adds one more step, the prior art's remaining steps cannot meet the claim as the claim does positively exclude this feature.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Andrew C Flanders/

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/CURTIS KUNTZ/

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